



Corres. and Mail
BOX AF

Xerox Docket No. D/99620

AF
JFW

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2176**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Michelle Q. Wang BALDONADO et al.

Group Art Unit: 2176

Application No.: 09/461,040

Examiner: M. NGUYEN

Filed: December 15, 1999

Docket No.: 104323

For: **SYSTEMS AND METHODS FOR ANNOTATING OBJECTS WHEN THE
ANNOTATION DEVICE DIFFERS FROM THE VIEWING DEVICE**

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 18, 2005 Final Office Action, reconsideration of the application is respectfully requested. Claims 1-37 are pending in this application.

The Final Office Action rejects claims 1-37 (maintained from the December 3, 2004 Office Action) under 35 U.S.C. §103(a) over U.S. Patent No. 6,173,287 to Eberman et al. ("Eberman") in view of "Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations", by Schilit et al., *CHI-98*, April 1998 ("Schilit"). This rejection is respectfully traversed.

Eberman and Schilit do not teach or suggest an annotation system that associates annotations with at least one object, the annotation system comprising a viewing device for viewing the at least one object, the viewing device being distinct from an annotation device, a